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10/773,955

01/31/2004

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09/10/2007

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

09/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,955

Applicant(s)

SEAN SHEK ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. The drawings are objected to because for figure 1, it is just not clear what the figure is directed to. While a person can read the specification to figure this out, the figure itself is of little or no value to anyone with respect to the disclosed invention. The examiner requests that applicant label the boxes in the figure so upon a review of the figure, a person can understand what the figure represents, even if in a very broad sense. Blocks with numbers are not clear, labels are required. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, the preamble recites that the invention being claimed is "a system *for application* in an automatic vending machine...". Later in the claim it is recited that some of the claimed systems are "structured as an automatic vending machine in a booth shape" and it is also recited that the system for supplying the discs is "structured as an automatic vending machine isolated from the automatic vending machine". This seems to contradict the preamble that states the invention is a system for application in a vending machine. Is the claim as a whole actually directed to a vending machine? This is not clear. How many vending machines are in the scope of the claim? This is not clear. Also not clear is really what defines the system that is being claimed. If the claimed system is for application in a vending machine, and some of the claimed structure is recited as being a vending machine, then what is the actual system that is for application in the vending machine. This is very confusing and renders the claim indefinite.

For claims 2,3, with respect to the recitation of "the automatic vending machine" which one is being referred to here? Claim 1 appears to recite at least two automatic vending machines. OR is the a reference to the automatic vending machine that the system is for application into? This is not clear. Also, it does not make sense to recite

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that the vending machine can be adapted without changing parts or components of the machine itself. To adapt something means you are changing it to some extent. What does not mean to claim that one can adapt something without actually changing it? This is indefinite language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrens-Burton (20030086123).

For claim 1, Torrens-Burton discloses a system for providing souvenir images and videos to customers by using a kiosk. A kiosk is a form of an automated vending machine. The product that is vended is the images either in print for or on cd (see

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paragraph 40). The controlling and processing system is 114. The payment handling system is 128, see paragraph 30. The data storage system is 117, see paragraph 25. The image recording system is disclosed in paragraph 36. To record video images, recording devices are required. The reproduction and output system is satisfied by the fact that cds can be produced that contain the desired images that the customer has selected. The power supply system is inherent to the system of Torrens-Burton. One cannot have a system such as is disclosed by Torrens-Burton without having a power supply system in the form of a connection to a power supply (i.e. connection to a source of electricity, such as a power plug). The system for supplying discs is disclosed in paragraph 40. Also see paragraph 36. Not specifically disclosed is that there is a sound recording system. Torrens-Burton discloses that videos may be provided to customers. One of ordinary skill in the art would readily appreciate the desirability of having a video with sound as opposed to a silent video. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Torrens-Burton with a sound recording system to be used in conjunction with the recording of the videos. One of ordinary skill in the art would have found it obvious to have a video that also included sound. This does not involve a level that skill that exceeds that of ordinary skill in the art.

For claims 2,3, if a person wanted to, they could adapt the system of Torrens-Burton to take a different form of currency, such as Canadian money, or even British currency. Any system can be adapted, which is what appears to be claimed as these claims are best understood by the examiner.

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Attenberg (5913019), Frey et al. (6369908), and Ghislain Bossut et al. (6750988) disclose systems that are related to the reproduction of images and videos by using a booth shaped type of a vending machine//kiosks.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DENNIS RUHL
PRIMARY EXAMINER